

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-20 have been rejected under 35 U.S.C. §112, second paragraph, wherein it is asserted that these claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-4, 8-10, 19 and 20 have been amended. As amended, any properly asserted rejection under 35 U.S.C. §112, second paragraph, no longer applies to claims 1-4, 8-10, 19 and 20 or to the claims directly or indirectly dependent on claims 1-4, 8-10, 19 and 20.

In addition, Applicant respectfully submits that “ the test for definiteness is whether one skilled in the art would understand the bounds of the claims when read in light of the specification . . . if the claims read in light of the specification reasonably apprised those skilled in the art of the scope of the invention, section 112 demands no more . . . . The degree of precision necessary for adequate claims is a function of the nature of the subject matter”. Miles Laboratory, Inc. v. Shandon, Inc. 997, F.2d 870 (Fed. Cir. 1993), cert. denied, 510 U.S. 1100 (1994).

Claim Rejections Under 35 U.S.C. § 103

Claims 1-20 have been rejected under 35 U.S.C. §103 as being unpatentable over Bretti et al (U. S. Patent No. 4,908,911). The courts have established the legal concept of *prima facie* obviousness and the initial burden of factually supporting any *prima facie* conclusion of obviousness rests on the Examiner. To properly establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143.

All Claimed Elements Not Present in Proposed Modification

Applicant respectfully asserts that the Examiner has not properly established a *prima facie* case of obviousness with respect to at least claim 1. Applicant notes that claim 1 is the sole independent claim upon which all other claims in the present application depend either directly or indirectly. On page 4 of the Office Action, the Examiner states "Bretti does not disclose a sensor". Furthermore, the Examiner contends that although "Bretti does however disclose a sequence/steps of events for operating the tool wherein various components act as a "sensor"".

Applicant asserts that the Examiner had not properly established a *prima facie* case of obviousness since, at least, all of the claimed limitations are not taught or suggested in the Brett reference. Brett simply does not have a sensor having a first sensing position in the absence of the lock, a second sensing position in the presence of the lock, and a third sensing position when the lock contains a band. A lack of all claimed elements is clear from the Examiner's conclusory statement that "various components act as a "sensor"". As such a rejection under 35 U.S.C. §103 is improper and should be withdrawn.

No Motivation or Suggestion to Modify Brett

It has been repeatedly held that when a single prior art reference is alleged to render the claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of that reference necessary to reach the claimed invention in order to support the obviousness conclusion. Sibia Neuroscis., Inc. v. Cadus Pharm. Corp., 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Sibia, 225 F.3d at 1356, 55 USPQ2d at 1931.

Brett contains no motivation or suggestion for the modification suggested by the Examiner. The Examiner has merely stated that "various components act as a "sensor"", and has shown no motivation or suggestion leading one of skill in the art to


a sensor having a first sensing position in the absence of the lock, a second sensing position in the presence of the lock, and a third sensing position when the lock contains a band. As such, the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

In summary, Applicant have addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

Respectfully Submitted,

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Fig. 3

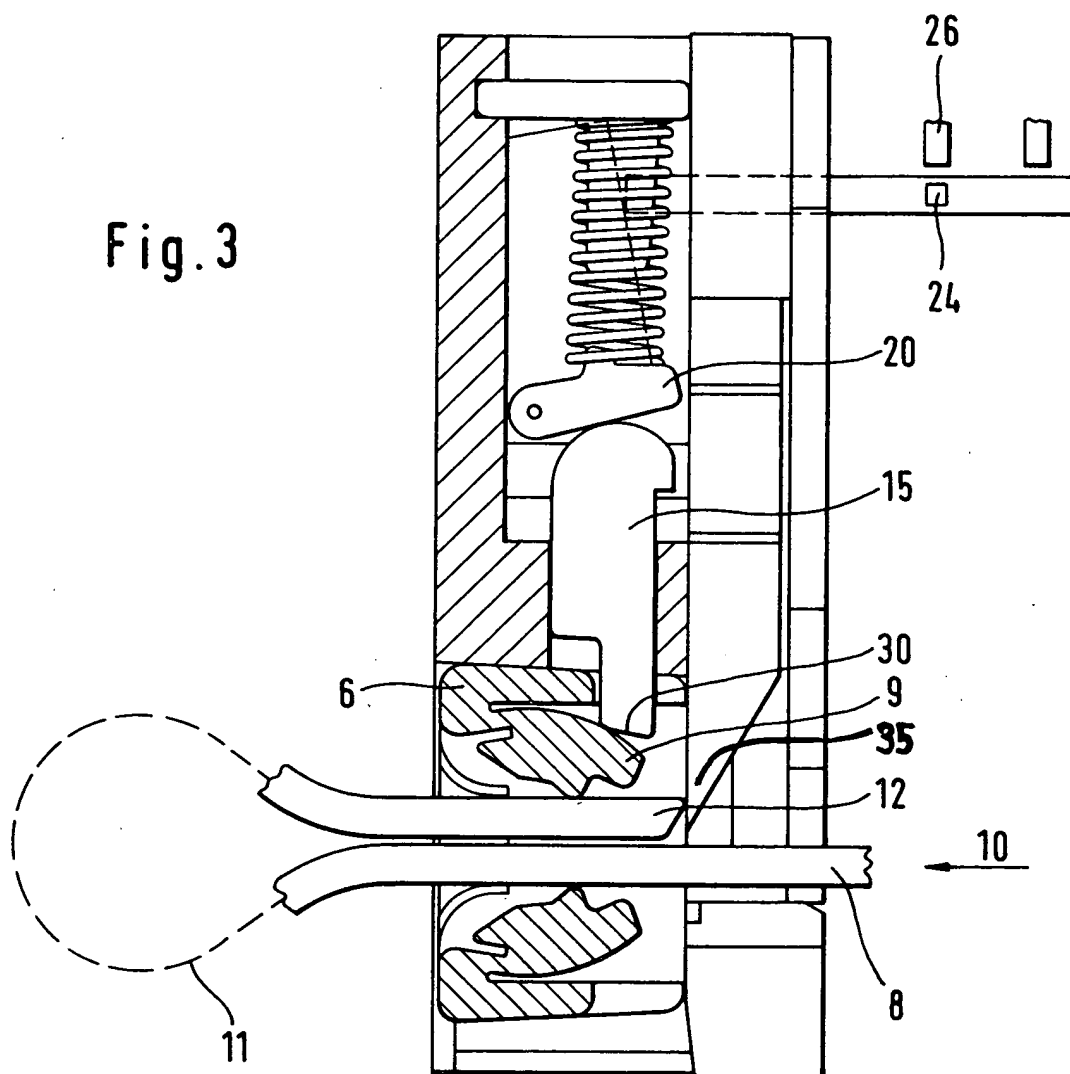


Fig. 4

